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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,071	11/21/2000	Jay C. Hsu	KCX-359 (15169)	1979

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,071

Applicant(s)

HSU ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-17, 19-22, 24-27, 29 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-17, 19-22, 24-27, 29 and 44-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1/22/03</u> . | 6) <input type="checkbox"/> Other: |

Art Unit: 1617

DETAILED ACTION

Claims 1-4, 7-17, 19-22, 24-27, 29 and 44-46 are pending. The Amendment filed 12/11/02, cancelled claims 30-40 and 42-43.

Applicant's argument's filed 9/10/02, Paper No. 10, are persuasive to overcome the 35 USC 112 rejections in the previous Office Action.

Applicant's arguments with respect to the 35 USC 103 rejection in the previous Office Action have been considered but are moot in view of the new ground(s) of rejection.

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/10/02 has been entered.

Election/Restrictions

Applicant's election without traverse of the Restriction Requirement in Paper No. 11 is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1617

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 11, 13, 14-17, 19-22, 26-27 and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 10-12, 14-17, 27-31, 34, 36, 38-40, 42 and 43-44 of copending Application No. 09/717,939. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The instant invention teaches a product in the form of a towel, wipe, or napkin, wherein the product comprises a paper web and a lotion composition, wherein the composition comprises 10-90% water, water soluble conditioner comprising 2-15% glycerin, and a viscosity increasing component comprising 2-20% of a surfactant, wherein the add-on level of the composition is 1-10% of the paper product.

'939 teaches a product in the form of a towel, wherein the product comprises a paper web and a lotion composition, wherein the composition comprises up to 90% water, an emollient, a fatty alcohol, an emulsifier, and up to 60%, preferably 10-40%) of a skin conditioning component, wherein the add-on level of the composition is 1-15% of the paper product. Glycerin is disclosed as an additional ingredient. Glyceryl stearate, a surfactant, is disclosed as a skin conditioning agent. The reference lacks preferred percent weights of glycerin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the glycerin of '939 as comprising 2-15% of the lotion composition because it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7-17, 19-21, 44 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase “said paper product being selected from the group consisting of towels, wipes, and napkins, said paper product comprising. . .” in claim 1 (lines 2-3) is vague and indefinite, as it is confusing. How can the paper product comprise a paper web and a towel, wipe, or napkin? Does not the paper web make up the towel, wipe or napkin? Is Applicant intending to claim the form of the paper product? The Examiner suggests the following to overcome this rejection: delete the phrase “said paper product being selected from the group consisting of towels, wipes, and napkins,” and add the following phrase to the last line of the phrase, “wherein the paper product is in the form of a towel, wipe, or napkin”.

(i) Claim 13 is rejected because the compound in these claims is not defined with any chemical or physical characteristic, but only by functional properties. A claim to a material defined solely in terms of what it can do, or a property thereof, does not particularly point out the

Art Unit: 1617

claimed invention. Thus, the scope is indefinite. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169. What surfactants are encompassed by this phrase? The specification does not define such surfactants and one of ordinary skill in the art would not be apprised of them.

- (ii) Claim 46 is vague and indefinite, as it depends from a claim that has been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7, 8, 11-17, 19-21 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimberly-Clark (WO 00/64408).

Kimberly-Clark teaches wet wipes comprising oil-in-water emulsions comprising 0.1-30% natural fat or oil, 0.1-10% sterol, 0.1-99.5% humectant, 0.5-20% emulsifying surfactant and water. The aqueous phase of the emulsion comprises alcohol and water. Water comprises 45-99.5% of the emulsion. Antimicrobials, antifungals, emollients, preservatives, and natural moisturizing agents are disclosed as additives. The basis weight of the wet wipes is 25-120g/m². Exemplified is an emulsion comprising 90% water, 5% glycerin, 3% glyceryl stearate SE (surfactant), borage oil, aloe, and tocopherol acetate. Sorbitol is taught as an additional humectant. Talloweth-60 myristyl glycol is taught as a preferred emulsifying surfactant. The reference lacks a teaching of the add-on level of the composition to the wipe. See pg. 4, lines 20-

Art Unit: 1617

29; pg. 5, lines 5-21; pg. 11, line 18-pg. 12, line 24; pg. 18, line 17-pg. 19, line 24; pg. 22, line 33-pg. 23, line 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kimberly-Clark to exemplify the emulsion as having an add-on level of 1-10% of the wipes because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 1-4, 7-11, 14-17, 19-22, 24-27, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammonds et al. (WO 98/03147).

Hammonds et al. teach wet wipes of fibrous sheet materials that are partially saturated with an aqueous solution comprising 0.5-50% oat extract and 10-90% solubilizing agent. The aqueous liquid comprises 0.5-10% of the composition. The wipes have a basis weight of 5-200 grams/m². The oat extract comprises skin protectants and emollients. Propylene glycol and sorbitol are disclosed as solubilizing agents. Emollients, moisturizers, additional surfactants, and preservatives are disclosed as additional ingredients. The solution may be added to the fibrous sheet material at an add-on level of about 0.1-50%. Towels are taught as another form of the product. The reference lacks an exemplification of the instant product. See pg. 2, lines 4-12 and 34; pg. 3, line 5-pg. 4, line 2; pg. 4, line 30-pg. 5, line 29; pg. 6, lines 1-8; pg. 5, lines 24-31; pg. 7, lines 16-35; pg. 14-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant paper product using the teachings of Hammonds et al. because a) Hammonds teaches a wet wipe or towel comprised of a paper web and a water-soluble

Art Unit: 1617

composition, wherein the add on level of the composition is 1-10% of the paper product, wherein water comprises 10% of the composition, glycerin comprises 10-90% of the composition, and the surfactant comprises 0.25-5% of the composition; b) Hammonds teaches glycerin as a solubilizing agent that effectively solubilizes the oat extract without irritating the skin; thus, one of skill in the art would be motivated to exemplify the paper product of Hammonds with glycerin as the solubilizing agent because of the expectation of achieving a product that does not irritate the skin.

Claims 12 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammonds as applied to claims 1-4, 7-11, 13-17, 19-22, 24-27, 29 above, and further in view of Kimberly-Clark.

Hammonds is applied as discussed above. The reference lacks talloweth-60-myristyl glycol.

Kimberly-Clark teach a wet wipe comprising an oil-in-water emulsion. Talloweth-60 myristyl glycol is disclosed as a preferred emulsifying surfactant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the talloweth-60 myristyl glycol taught by Kimberly-Clark to the composition of Hammonds because a) Kimberly-Clark teach talloweth-60 myristyl glycol as an emulsifying surfactant useful in cosmetic compositions; b) Hammonds teaches that surfactants can be added to her compositions as solubilizing agents to avoid using the skin irritants butylene and propylene glycol; thus, one of skill in the art would be motivated to add talloweth-60 myristyl glycol to the composition of Hammonds in place of butylene glycol or propylene glycol because of the expectation of achieving a product that does not irritate the skin.

Art Unit: 1617

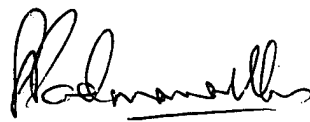
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
January 29, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

2/9/03